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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/733,900      | 12/12/2000  | Carlos O. Pinzon     | 05725.0595-00       | 5474             |

22852 7590 07/16/2003

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EXAMINER

LAMM, MARINA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1616

DATE MAILED: 07/16/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/733,900

Applicant(s)

PINZON ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-346 is/are pending in the application.
- 4a) Of the above claim(s) 1-320,323,324,326-328,331-333,336 and 339-346 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 321,322,325,329,330,334,335,337 and 338 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 7, 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election with traverse of Group III, Claims 321, 322, 325, 329, 330, 334, 335, 337 and 338, in Paper No. 14 is acknowledged. The traversal is on the ground(s) that examining Groups I-V together will not constitute a serious burden because "all of the claims recite, *inter alia*, a composition comprising at least one liquid fatty phase comprising at least one structuring polymer and at least one oil-soluble surfactant". This is not found persuasive because the different groups all contain different elements (e.g. anhydrous compositions in Group II, cosmetic/make-up compositions in Group III, deodorant compositions in Group IV, lipstick composition in Group V), thus requiring different field of searching as shown by the separate classification. Further, with respect to the lipstick composition of Group V, the non-waxy structuring polymer recited in Claim 326 is not necessarily the same polymer as recited in claims of Group III.

The requirement is still deemed proper and is therefore made **FINAL**.

2. Applicant's election with traverse of the following species: (1) Uniclear 100 (i.e. copolymers derived from monomers of C<sub>36</sub> diacids and ethylenediamine with terminal ester groups resulting from esterification of the remaining acid group with at least one alcohol chosen from cetyl alcohol, stearyl alcohol and mixtures thereof), as a structuring polymer, and (2) Gluquat-100 (i.e. lauryl methyl gluceth-10 hydroxypropyl dimonium chloride), as an oil-soluble cationic surfactant, is acknowledged. The traversal is on the ground(s) that "the Examiner has not shown that there would be a serious burden to examine all of the claimed species." This is not found persuasive because the Applicant's claimed structuring polymer and

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oil-soluble cationic surfactant, each encompasses a plurality of species which require a burdensome classification, and/or bibliographic, manual and computer search. For examples, the Applicant's claimed structuring polymer comprising a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom, encompasses hundreds if not thousands of different polymers and would take an enormous amount of time and effort to search.

#### *Status of the Claims*

3. Claims pending are 1-346. Claims 1-320, 323, 324, 326-328, 331-333, 336 and 339-346 are withdrawn from further consideration as directed to non-elected invention. Claims 321, 322, 325, 329, 330, 334, 335, 337 and 338 are being examined at this time.

#### *Oath/Declaration*

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c). Thus, the citizenship information of the first invention has been altered.

#### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 321, 322, 325, 329, 330, 334, 335, 337 and 338 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavlin et al. (US 5,783,657) in view of Murphy et al. (US 6,423,324), "McCutcheon's Emulsifiers and Detergents" (vol. 1, pp. 272-273, 1993) and Seidel et al. (US 5,830,483).

Pavlin et al. teach ester-terminated polyamide ("ETPA") resin of the instant invention. See col. 2-13. In particular, the ETPA resin of Pavlin et al. is formed from monoalcohol (e.g. cetyl alcohol, stearyl alcohol), diacid (e.g. C<sub>36</sub> dicarboxylic acid formed by dimerization of the fatty acid), and diamine (e.g. ethylenediamine). See col. 7, lines 49-51; col. 8, lines 4-10, 51-52; col. 10, lines 18-20. The polyamide resin is useful in forming gels with liquid hydrocarbons such as oils. See col. 13, lines 47-49; col. 15, lines 16-44; col. 16, lines 12-20. The gels of Pavlin et al. are stable, i.e. they do not exhibit syneresis. See col. 16, line 63 – col. 17, line 6. The gels of Pavlin et al. are prepared by combining the ETPA resin with a hydrocarbon. See col. 17, lines 7-23. The gels are then formulated into personal care products, such as lipsticks and make-up compositions, by combining with conventional cosmetic ingredients such as colorants, emulsifiers, etc. See col. 14, lines 28-43; col. 17, lines 24-30. Pavlin et al. do not explicitly teach oil-soluble cationic surfactant of the instant invention. However, Murphy et al. teach combining polyamide resins with surfactants, including cationic surfactants, for reducing susceptibility of the composition to syneresis, modifying viscosity and improving the texture of the composition. See col. 9, lines 1-5; col. 10, lines 46-52. The useful cationic surfactants include oil-soluble cationic surfactants such as quaternary ammonium compounds and fatty amines. See "McCutcheon's Emulsifiers and Detergents", pp. 272-273. With respect to the elected species of the cationic surfactant, Seidel et al. teach using cationic surfactants, including lauryl methyl

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gluceth-10 hydroxypropyl dimonium chloride, in cosmetic compositions for adjusting viscosity and achieving "rich appearance". See col. 3, lines 40-67; col. 4, lines 11-14, 46-53. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Pavlin et al. such that to employ cationic surfactants. One having ordinary skill in the art would have been motivated to do this to further improve the stability and appearance of the Pavlin's compositions by reducing susceptibility of the composition to syneresis, modifying viscosity and improving the texture of the compositions as suggested by Murphy et al. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ lauryl methyl gluceth-10 hydroxypropyl dimonium chloride as a cationic surfactant in compositions of Pavlin et al. in view of Murphy et al. for its art recognized purpose, i.e. for adjusting viscosity, as suggested by Seidel et al. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See MPEP 2144.07.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

7. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

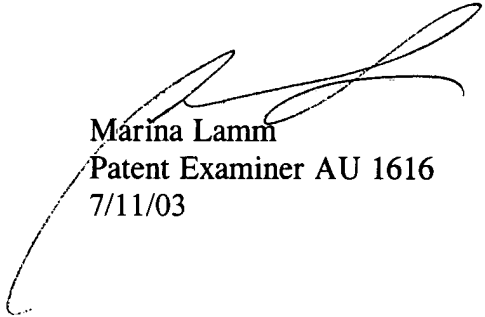
The examiner can normally be reached on Monday to Friday from 9 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (703) 308-2927.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Marina Lamm  
Patent Examiner AU 1616  
7/11/03